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10/074,832

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Timothy L. Kelliher

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04/17/2006

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EXAMINER

TSE, YOUNG TOI

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,832

Applicant(s)

KELLIHER, TIMOTHY L.

Examiner

YOUNG T. TSE

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,5-10 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☒ Claim(s) 5-10 and 16-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed October 21, 2005 have been fully considered but they are not persuasive. The Applicant argues that the double patenting rejection has been overcome by the amended claim 3 to add a new limitation that is not found in the claims of the cited application. However, the amendment to claim 3 of the instant application and the amendment to claim 1 of the co-pending Application No. 10/159,496 contained similar claimed subject matter. Therefore, the double patenting rejection of claim 3 is provisionally rejected under the judicially created doctrine of double patenting over claim 1 of copending Application No. 10/159,496 stands.
2. Applicant's arguments, see pages 21-22, filed October 21, 2005, with respect to claims 4-5, 9-10 and 16-18 have been fully considered and are persuasive. The rejection of claims 4-5, 9-10 and 16-18 has been withdrawn.

Claim Objections

3. Claims 3, 5-10 and 16-22 are objected to because of the following informalities:

In claim 3, line 1, "method of" should be "method for"; line 5, "OAM/EOC" should be "operation administration maintenance/embedded operations channel (OAM/EOC)"; line 12, "devices;" should be "devices; and"; lines 13, 19 and 20, "of M" should be "of corresponding M"; lines 15 and 17, "of P" should be "of corresponding P"; and line 16, "so user traffic data may be" should be "so the user traffic data is".

In claim 5, lines 2 and 3, "of M" and "RTS/CTS" should be "of corresponding M" and "reset-to-send/clear-to-send (RTS/CTS)", respectively.

Claim 6 is objected to because it is depended upon claim 5.

In claim 7, lines 1-2, "the bandwidth requirements of the synchronization data is less than about 1 percent of that" should be "a bandwidth requirement of the synchronization data is less than about 1 percent of a bandwidth requirement".

In claim 8, line 3, "of user" should be "of the user"; line 5, "the first set of M" should be "the set of corresponding M"; and line 6, "are met" should be "is met".

In claim 9, line 5, "OAM/EOC" should be "operation administration maintenance/embedded operations channel (OAM/EOC)"; lines 9 and 12, "customer premise" should be "first customer premise"; lines 14, 16 and 17, "customer premise" should be "second customer premise"; and line 15, "a second" should be "the second".

In claim 10, line 2, "RTS/CTS signals between the" should be "reset-to-send/clear-to-send (RTS/CTS) signals between at least one of the plurality of"; line 3, "device and" should be "devices and"; and line 4, "of a P" should be "of P".

In claim 17, line 2, "optical fiber, a twisted pair conductor, the" should be "an optical fiber, a twisted pair conductor, a".

Claims 16 and 18 are objected to because they are depended upon claim 9.

In claim 19, lines 6 and 13-14, "an OAM/EOC modem" and "the OAM/EOC modem" should be "one of a group of P operation administration maintenance/embedded operations channel (OAM/EOC) modems" and "one of the group of P OAM/EOC modems", respectively.

In claim 20, line 3, and "OAM/EOC modem" and "RTS/CTS" should be "one of the group of P OAM/EOC modems" and "reset-to-send/clear-to-send (RTS/CTS)", respectively.

Claim 21 is objected to because it is depended upon claim 19.

In claim 22, lines 1-2, "the bandwidth requirements of the synchronization data is less than about 1 percent of that" should be "a bandwidth requirement of the synchronization data is less than about 1 percent of a bandwidth requirement".

Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 3 is provisionally rejected under the judicially created doctrine of double patenting over claim 1 of copending Application No. 10/159,496. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: the claimed subject matter of claim 3 of the instant application is broader than the claimed subject matter of claims 1 of copending Application No. 10/159,496, although the P OAM/EOC modems of the instant application are different of the P low bandwidth synchronization modems of the copending Application No. 10/159,496, the function for the modems are the same of transferring synchronization data between the modems and a set of P customer premise equipments. Although the conflicting claims 3 and 1 are not identical, they are not patentably distinct from each other because the broader claims of the instant application would have been obvious in view of the narrow issued claims of the copending Application No. 10/159,496 (see *In re Emert*, 124 F.3d 1458, 44USPQ2d 1149).

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Allowable Subject Matter

6. Claim 3 would be allowable if rewritten or amended to overcome the objection(s) set forth in this Office action and file a terminal disclaimer to overcome the double patenting rejection.
7. Claims 5-10 and 16-22 would be allowable if rewritten or amended to overcome the objections(s) set forth in this Office action.

Conclusion

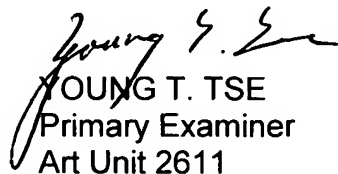
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Abramson et al. discloses testing and switching systems for measuring network and system parameters including signal level, phase jitter, and noise.
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOUNG T. TSE whose telephone number is (571) 272-3051. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel can be reached on (571) 272-2988. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


YOUNG T. TSE
Primary Examiner
Art Unit 2611